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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/246,409	02/08/1999	SHMUEL SHAFFER	99-P-7454-US	6137

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SIEMENS CORPORATION
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EXAMINER

CHOW, MING

ART UNIT PAPER NUMBER

2645

12

DATE MAILED: 12/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/246,409

Applicant(s)

SHAFFER ET AL.

Examiner

Ming Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Objections

1. Claim 8, on page 3 of paper No. 11, is objected to for being marked as “currently amended” while the Examiner finds that there is no amendment to this claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Kennedy (US: 6330589). Kennedy teaches on item 38 Fig. 3 “local message store” (claimed “memory”).

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Kennedy teaches on Fig. 4a and 4b messages are threaded with other one or more messages. Kennedy also teaches on column 3 line 47-50 the reply message (claimed “threaded message”; see line 4-5 page 8 of the specifications for definition of “thread messages” by Applicant) includes a message identifier for a root message (claimed “includes at least a portion of another message”). Kennedy further teaches on column 3 line 53-58 and Fig. 5 the root message (claimed “another message”) and reply message are grouped (to be a threaded message). Kennedy also teaches on item 36 Fig. 3 email program module (claimed “controller”; including item 37 Fig 3 message manager program module).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 1 above. Kennedy teaches on Fig. 4c “message 2” (claimed “a message threaded within another message”). Kennedy failed to teach “controller being.....has been accessed”. However, “Official Notice” is taken that a message (including the original message

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and its threaded reply message) is indicated as has been accessed is old and well known to one skilled in the art. When the message is indicated “accessed” any message included in is inherently indicated “accessed”.

4. Claims 3-7, 11-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 2 above, and in view of John Alson Hicks, III (US-PAT-NO: 6,304,573 B1).

Regarding claim 3-7, 11-15, 17, 19, Kennedy failed to teach the deleting and saving actions by the controller to the email and voice mail messages. However, Hicks teaches on Column 3 Line 49 the actions of deleting and saving on the email and voice mail messages (Column 3 Line 62). It would have been obvious to one skilled at the time the invention was made to modify Kennedy for including the deleting/saving actions to the email and voice mail messages such that the modified system of Kennedy would be able to support these well known deleting/saving features to the system users.

Regarding claims 18 and 20, Kennedy teach on column 8 line 4-11 the system provides phone support. Kennedy also teach on column 7 line 52-54 the connections include a LAN. Therefore, Kennedy’s system comprises a telephony-over-LAN messaging system.

5. Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy as stated in claim 1 above, and in view of Lytle et al (US: 6549950). Kennedy failed to teach “said controller.....another message”. However, Lytle et al teach on Fig. 23 en email reply to an

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original email message. The email reply shown on Fig. 23 is the claimed “a message which is threaded within another message”. When the original email sender opens this reply email the original mail sender is prompted with options as “Message”, “Options”, “Other”, and “Customer” on Fig. 23.

Response to Arguments

6. Applicant's arguments filed on 9/19/03 have been fully considered but they are not persuasive.
 - i) Applicant argues, on page 5, regarding claimed limitations “threaded” and “a threaded message includes at least a portion of another message”. Relative to line 26 page 6 to line 12 page 7 of the instant application’s specification, when a message is threaded within another message, typically, only new headers are transferred and stored. The headers then are used to point to locations in the memory where the full body of the threaded messages are stored. When more inclusive messages are played back, then, the controller will use the header information to access locations in memory where the thread components are stored. Therefore, the “thread” and “threaded” messages are NOT physically contained in one another. The instant application discloses using a “header” to thread the messages. This is the same, as rejection stated in claim 1 above,

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as the referenced prior art (Kennedy) teaches using the message identifier (message header) to thread the messages. Further, Kennedy teaches on column 3 line 47-50 the reply message includes a message identifier for a root message (reads on claimed “includes at least a portion of another message”).

- ii) Applicant argues, on page 6, regarding claim 2. The “Official Notice” forms the basis for the rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communication from the examiner should be directed to the examiner Ming Chow whose telephone number is (703) 305-4817. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service whose telephone number is (703) 306-0377. Any inquiry of a general nature or relating to the status of this application or proceeding should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to Central FAX Number 703-872-9306.

Patent Examiner

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Ming Chow



FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

